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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,105	10/30/2006	Markus Jakobuss	128346.30301	6157

7590 11/19/2008
Pepper Hamilton
One Mellon Center 50th Floor
500 Grant Street
Pittsburgh, PA 15219

EXAMINER

MCDONALD, SHANTESE L

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,105	Applicant(s) JAKOBUSS ET AL.	
	Examiner SHANTESE MCDONALD	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4,6-9 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,6-9 and 37-40 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ashley.

Ashley teaches a frame saw system comprising a plurality of space apart, substantially parallel blades, 70, connected to a frame, 25, and at least one support structure, 27, 28, 71, which are tensioning rods, (col. 2, lines 68-72), supplied perpendicularly across the blades and adhering to at least one of the blades in fixed relative position, clamps, which contact the two outermost blades, wherein the clamps comprise a plate, 41a, 42a, bolts, 53a tightened against the plate, (col. 3, lines 41-50), spacers located longitudinally between the blades, wherein the support structure is capable of being removed from the frame saw system as the blades are engaged in cutting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,4,9 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashley in view of Lin

Ashley teaches all the limitations of the claims except for the blades comprising super abrasive containing segments, and the support structure comprising a polymeric foam including material selected from the group consisting of a polyurethane, a polyethylene, and a polystyrene. Lin teaches blades comprising super abrasive segments, 26, (col. 9, lines 34-48). It would be obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Ashley with super abrasive segments, as taught by Lin, in order to enhance the saw capabilities. It would have been further obvious to provide the tool of Ashley with the spacers of the support structure being made of a polymeric foam including material selected from the group consisting of a polyurethane, a polyethylene, and a polystyrene, as an obvious matter of design choice.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10/31/08 have been fully considered but they are not persuasive.

It appears that you are claiming method steps in your apparatus claims. The Ashley reference teaches a support structure, 27,28,71, that is supplied perpendicularly across the blades, and that adhere to at least one of the blades for keeping the blades in a fixed relative position. The added limitation of the support structure being applied in a fluidic form is a method step. The method of applying/attaching the support structure does not hold any patentable weight in an apparatus claim. Also, the limitation of removing or pulling away the support structure doesn't hold patentable weight in the apparatus claim. When the blades are not engaged in cutting, then the support structure is still attached to the frame saw, which is taught by Ashley. The spacers, 71, of Ashley are a part of the support structure. It is known in the art to provide the spacers in between the blades in order to keep the blades in the fixed relative position. It is also known in the art to construct the spacers out of different material, and therefore to construct them spacers out of a polymeric foam, would be an obvious matter of design choice. If one were to construct the spacers of Ashley out of a polymeric foam, then the support structure of Ashley would comprise a polymeric foam.

The Examiner suggest possible claim limitations for claims 1 and 38.

In claim 1, it is suggested to amend the claim along the lines of

“at least one fluidic support structure of unifying material supplied perpendicularly across the blades and adhering to at least one of the blades for keeping the blades in fixed relative positions;

the fluidic support structure curing to form a cohesive mass bonding to at least one of the blades;”

In claim 38

“at least one fluidic support structure of unifying material supplied perpendicularly across the blades and adhering to at least one of the blades for keeping the blades in fixed relative positions wherein the support structure comprises a polymeric foam which is cured to form a cohesive mass bonding to at least one of the blades:”

The Examiner also suggest that the limitation of the support structure being “capable of” being removed or pulled away from the frame saw system as the blades are engaged in cutting, be added into the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANTESE MCDONALD whose telephone number is (571)272-4486. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.L.M.

November 13, 2008

/Joseph J. Hail, III/

Supervisory Patent Examiner, Art Unit 3723